

**REMARKS**

**REVIEW**

The current application sets forth Claims 1 through 20 of which Claims 1 and 10 are independent claims. Presently, no claims have been indicated as allowed in view of the prior art.

Claims 1-7, 9, 11-17, and 19 stand collectively rejected under 35 U.S.C. §102(b) as being allegedly anticipated by *Bassett*, U.S. Patent No. 3,057,624 ("*Bassett*"). Claims 1-7, 9, 11-17, and 19 also stand rejected under 35 U.S.C. §103(a) as being allegedly obvious under *Bassett*, U.S. Patent No. 3,057,624 in view of *Ward*, U.S. Patent No. 4,060,246 ("*Ward*"). Claims 4-7, 9, 14-17, 19 stand rejected under, 35 U.S.C. §102(b) or, in the alternative, 35 U.S.C. §103(a) as unpatentable over *Bassett* in view of *Ward* and in further view of *Somerville*, U.S. Patent No. 4,828,268 ("*Somerville*"). Claims 8 and 18 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Bassett* in view of *Ward* and of *Somerville* and further in view of *Grutta*, U.S. Patent No. 2,972,833 ("*Grutta*"). Finally, Claims 10 and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Bassett* in view of *Ward* and of *Somerville* and further in view of *Kleva*, U.S. Patent No. 4,341,386 ("*Kleva*").

### AMENDMENTS TO CLAIMS

The claims have been amended to more fully distinguish the present invention from the prior art. Support for the amendments is found at paragraphs 0041-2 and Figures 2 and 3 of the Application. No new matter has been added.

### 35 U.S.C. §102(b) REJECTION

The claims have again been amended to address the 35 U.S.C. §102(b) rejection and Applicant respectfully traverses such ground of rejection with the above amendments. *Bassett* fails to teach or suggest an adaptable, hand-drawn map using a dry-erase marker. Therefore, the invention is not anticipated by *Bassett* and withdrawal of rejection and allowance is respectfully requested. Based upon the above-described distinction and the above amendments, it is asserted that Claims 1 and 11 and their respective dependent claims are now in condition for allowance and acknowledgment of the same is earnestly solicited.

Nonetheless, Applicant is compelled to respond to Examiner's assertion that simply because *Bassett* mentions that the board disclosed may be made of plastic, that the present invention is taught. Examiner proposes, very broadly, that "plastic" is suitable for use with dry-erase markers. *Bassett* does not discuss the board surface or even marking upon it. Therefore, Examiner's argument relies on anticipation through inherency.

The law is well-settled that “[I]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 1949, 1950-1 (Fed. Cir. 1999); *see also Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999), *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 314 (Fed. Cir. 1983). A surface upon which a dry-erase marker may be used such that marks made thereon are erased without resort to solvent or rubbing may indeed be constructed of plastic. However, that is not always the case. It is well-known in the art that the surface of the material to be used must be treated by sealing or otherwise, or rendered substantially non-porous, smooth and hard to be compatible with dry-erase markers. This is especially true where, as here, there is printing upon the board. The print must also be dry-erase compatible as well. *Bassett* in no way teaches the treatment of the surface of its board in order to anticipate the case where dry-erase markers may be used upon the surface. Therefore, the present invention is not inherently disclosed by *Bassett*.

### **35 U.S.C. §103(a) REJECTIONS**

In view of the above amendments, Applicant again respectfully traverses all such grounds of rejection. By relying on rejection grounds under 35 U.S.C. §103(a) for alleged obviousness, and by various statements throughout the detailed Office Action, the PTO already acknowledges certain important deficiencies of the base reference, *Bassett*, which renders such base reference

inadequate for serving as a rejection basis by itself for any of Claims 4 through 10 and 14 through 20.

An invention is only obvious under 35 U.S.C. §103(a) if "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §103(a) (*Emphasis added*). The task of proving obviousness is not merely establishing that all of the elements of a claimed invention would have been obvious. It must be shown that the particular combination of elements used to form the whole invention would have been obvious. There must be some suggestion, incentive, or motivation to combine the elements in the manner as in the claimed invention.

1. Claims 1-7, 9, 11-17, and 19.

*Bassett* in view of *Ward* fails to render the present invention obvious under §103(a). Whether "one skilled in the art might find it obvious to try various combinations...is not the standard." *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital, et al.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). "There must be some reason, suggestion, or

motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” In re Oetiker, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992).

Neither reference teaches or suggests an adaptable, hand-drawn map using a dry-erase marker, nor do they in combination teach this characteristic of the present invention. Therefore, the invention is not rendered obvious by this combination and withdrawal of rejection and allowance is respectfully requested.

2. Claims 4-7, 9, 14-17, 19.

Examiner asserts that the subject Claims are rendered obvious by *Bassett* in view of *Ward* in further view of *Somerville*. None of the references teaches or suggests an adaptable, hand-drawn map using a dry-erase marker, nor do they in combination teach this characteristic of the present invention. Therefore, the invention is not rendered obvious by this combination and withdrawal of rejection and allowance is respectfully requested.

3. Claims 8 and 18

Examiner asserts that the subject Claims are rendered obvious by *Bassett* in view of *Ward* and *Somerville*, and in further view of *Grutta*. None of the references teaches or suggests an adaptable, hand-drawn map using a dry-erase marker, nor do they in combination

teach this characteristic of the present invention. Therefore, the invention is not rendered obvious by this combination and withdrawal of rejection and allowance is respectfully requested.

4. Claims 10 and 20

Finally, the subject Claims are rejected as being allegedly obvious under §103(a) over *Bassett* in view of *Ward* and *Somerville* in further view of *Kleva*. None of the references teaches or suggests an adaptable, hand-drawn map using a dry-erase marker, nor do they in combination teach this characteristic of the present invention. Therefore, the invention is not rendered obvious by this combination and withdrawal of rejection and allowance is respectfully requested.

In summary, the combined teachings of the references fail to disclose or suggest the subject matter of the claims at issue. That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. In view of these considerations, it is submitted that the rejection of the claims as amended is no longer tenable and should be withdrawn. The claims should be deemed patentably distinct over the art and should be allowed.

**CONCLUSION**


In view of the foregoing amendments and comments, Applicant respectfully requests withdrawal of the current grounds of rejection and the issuance of a formal Notice of Allowance. The Examiner is invited to telephone the undersigned at his convenience should only minor

issues remain after consideration of this amendment in order to permit early resolution of the same.

Respectfully submitted,

April 11, 2005

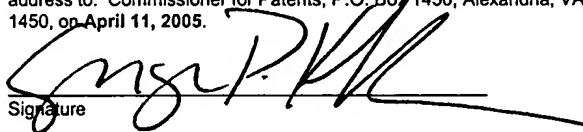
Date

  
George P. Kobler  
Reg. No. 46,837

LANIER FORD SHAVER & PAYNE P.C.  
Customer Number 021491  
P.O. Box 2087  
Huntsville, Alabama 35804-2087  
Phone: (256) 535-1100  
Fax: (256) 533-9322

Certificate of Mailing under 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 11, 2005.

  
Signature